

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARK W. BRUNS

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Appeal No. 1999-1569  
Application 29/021,723

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ON BRIEF

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Before McCANDLISH, Senior Administrative Patent Judge, and  
McQUADE and WARREN, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Mark W. Bruns appeals from the final rejection of the  
following claim for an ornamental design:

The ornamental design for the COMBINE PLATFORM AUGER  
FINGER GUIDE as shown and described.

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In response to a request for information (Paper No. 2), the appellant submitted material (Paper No. 3) indicating that a combine platform auger finger guide is an article of manufacture which is adapted to be mounted on the tubular wall of a combine platform auger to guide crop-engaging fingers that are mounted within and movable through the wall.

The claim stands rejected under 35 U.S.C. § 171 as being directed to subject matter which is non-statutory because it lacks ornamentality.

Under § 171, a design patent may be granted only for a new, original and ornamental design. When a configuration is the result of functional considerations only, the resulting design is not patentable as an ornamental design for the simple reason that it is not ornamental. In re Carletti, 328 F.2d 1020, 1021-22, 140 USPQ 653, 654 (CCPA 1964). In other words, if a design is primarily functional rather than primarily ornamental, it cannot be patented. See L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123, 25 USPQ2d 1913, 1917 (Fed. Cir.), cert. denied, 114 S.Ct. 291 (1993);

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Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.,  
853 F.2d 1557, 1563, 7 USPQ2d 1548, 1553 (Fed. Cir. 1988);  
Power Controls Corp. v. Hybrinetics, Inc., 806 F.2d 234, 238,  
231 USPQ 774, 777 (Fed. Cir. 1986).

In the present case, the examiner submits that the  
claimed design for a combine platform auger finger guide lacks  
ornamentality because

[a]rticles of this type would seem to be devised to  
satisfy purely structural and mechanical  
requirements as well. No concern for ornamental  
value may be ascribed to its functional features. A  
potential purchaser and user of the claimed article  
would not select it on the basis of any  
consideration other than utility [first Office  
action, Paper No. 4, page 2].

The examiner further explains that "due to the title, the  
utilitarian configuration, and lack of ornamental features of  
the article, . . . it was proper to give the rejection under  
35 U.S.C. 171 as lacking ornamentality based [on] the  
examiner's knowledge of [the] art" (examiner's answer, Paper  
No. 13,  
page 2).

To reject a claim, an examiner bears the initial burden of presenting a factual basis establishing a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445-46, 24 USPQ2d 1443, 1444-45 (Fed. Cir. 19922); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If this burden is met, the burden of coming forward with a showing of facts supporting the opposite conclusion shifts to the applicant. After such rebuttal evidence is submitted, all of the evidence must be considered anew, with patentability being determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument. Of course, if the examiner's initial showing does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. Id.

With regard to the rejection at bar, the examiner's determination that the claimed design for a combine platform auger finger guide is functional rests solely on a series of unsupported and purely conjectural assertions, rather than on a sound and cogently explained factual basis. Hence, there is

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no prima facie case here that the claimed design lacks  
ornamentality. Accordingly, we shall not sustain the standing  
35 U.S.C. § 171 rejection of the appellant's claim.

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The decision of the examiner is reversed.

REVERSED

HARRISON E. McCANDLISH	)	
Administrative Patent Judge	)	
	)	
	)	BOARD OF PATENT
	)	APPEALS AND
	)	INTERFERENCES
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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WARREN, Administrative Patent Judge, Concurring:

I concur with the panel's decision to reverse the decision of the examiner based on the record before us for the following reasons.

"The 'ornamental' requirement of [35 U.S.C. § 171] . . . means that the design must not be governed solely by function, *i.e.*, that this is not the only possible form of the article that could perform its function. . . . A design patent is for a useful article, but patentability is based on the design of the article, not the use." Seiko Epson Corp. v. Nu-Kote International Inc., 190 F.3d 1360, 1368, 52 USPQ2d 1011, 1017 (Fed. Cir. 1999), citing L.A. Gear Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123, 25 USPQ2d 1913, 1917 (Fed. Cir. 1993); see also Best Lock Corp. v. Ilco Unican Corp., 94 F.3d 1563, 1566, 40 USPQ2d 1048, 1049-50 (Fed. Cir. 1996); Power Controls Corp. v. Hybrinetics, Inc., 806 F.2d 234, 238-40, 231 USPQ 774, 777-78 (Fed. Cir. 1986); In re Carletti, 328 F.2d 1020, 1021-22, 140 USPQ 653, 654 (CCPA 1964) ("[I]t has long been settled that when a configuration is the result of functional



considerations only, the resulting design is not patentable as an ornamental design for the simple reason that is it not 'ornamental' - as not created for the purpose of ornamenting. [Citations omitted.]"). "In determining whether a design is primarily functional or primarily ornamental the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article. [Citations omitted.]" L.A. Gear, supra. "When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose. [Citations omitted.]" Id. Thus, when viewed in its entirety, "[I]f the particular design is essential to the use of the article, it can not be the subject of a design patent." Id.; see also Power Controls, supra (patent is invalid if the claimed design is primarily functional rather than ornamental).<sup>1</sup>

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<sup>1</sup> Contrary the position advanced by appellant in his brief,  
(continued...)

I find that the issue of whether the claimed design of the combine platform auger finger guide encompassed by the claim on appeal, when viewed in its entirety, is primarily functional, has not been developed on the record by either the examiner or appellant. The examiner cites her "knowledge of the art" as the basis for alleging that the claimed design has "utilitarian configuration, and lack of ornamental features," and thus contends that the burden has therefore shifted to appellant to establish by testimony that the design was created "for primarily ornamental purposes" (answer, pages 2-3). For his part, appellant has testified, inter alia, that

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(...continued)

filed April 1, 1996 (Paper No. 11½; pages 3-4), whether the claimed design is "ornamental" within the meaning of § 171 is not a matter of aesthetics. See Seiko Epson, 190 F.3d at 1368, 52 USPQ2d at 1017-18 ("Nor need the design be aesthetically pleasing. . . . The design may contribute distinctness or consumer recognition to the design, but an absence of artistic merit does not mean that the design is purely functional."); Carletti, supra ("The appearance of appellants' gasket seems as much dictated by functional considerations as is the appearance of a piece of rope, which, too, has ribs and grooves nicely arranged. The fact that it is attractive or pleasant to behold is not enough. Many well-constructed articles of manufacture whose configurations are dictated solely by function are pleasing to look upon, for example, a hex-nut, a ball bearing, a golf club, or a fishing rod, the pleasure depending on one's interests.").

"[t]he head has bilateral symmetry, as it is equally proportioned on opposite sides of vertical and horizontal lines. The outline of the head is an arbitrary shape."<sup>2</sup> The examiner submits that appellant's testimony "did not disclose any areas of the invention as being created for ornamental purposes" (answer, page 3).

The evidence of record with respect to the designs of combine platform auger finger guides known in the art is provided by the utility patents supplied in the information disclosure statement filed by appellant on August 8, 1994 (Paper No. 3) and the utility patents supplied by the examiner in the Office action of March 21, 1995. It is apparent from even a cursory review of this patent literature that the design of each auger finger guides is dictated by, inter alia, the shape, size and movement of the particular auger finger, provision for bearing surfaces and/or lubrication as required in each instance, the mating of the guide to the aperture in the wall of the auger drum through which the finger moves in

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<sup>2</sup> Declaration Under 35 CFR §1.131 [sic, 37 CFR § 1.132], filed July 3, 1995 (Paper No. 6; ¶ 2). See also brief (pages 1-2).

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each instance, and, of course, the contour of each augur drum.

This evidence would reasonably appear to provide the basis for a finding that prima facie the claimed design when viewed in its entirety is primarily functional in that it is primarily adapted for a specific auger finger guide application, rather than an alternative or arbitrary design intended for use with a number of different auger finger applications and created for the purpose of ornamenting. Cf. Best Lock, 94 F.2d at 1566, 40 USPQ2d at 1050; Power Controls, 806 F.2d at 239-40, 231 USPQ at 778; Carletti, supra; cf. also L.A. Gear, supra. Indeed, the evidence of record would reasonably provide the basis for the examiner to inquire into appellant's reasoning behind the design in its entirety and for appellant to submit evidence that the design is primarily ornamental. See Power Controls, supra; Carletti, 328 F.2d at 1021, 140 USPQ at 654; see also Best Lock, supra. As noted above, on this record, appellant has testified that the "outline of the head is an arbitrary shape" which, of course, involves less than the overall appearance of the article. Cf. Carletti, 328 F.2d at

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1022, 140 USPQ at 655 ("Neither does it suffice to argue, as appellants do, that the ribs and grooves *could* have been less gracefully arranged than they are in their actual 'balanced relationship.' If obviousness enters into this case, it is at this point. If it is desired to employ a groove for flexibility and three concentric ribs to make a good seal on a flat drum head, what is more obvious than to arrange them with approximately equal spacing, as was done? But it was done without thought of ornament. The creation or origination of an ornamental design does not reside in the mere avoidance of dissymmetry.")

However, the examiner has not made such a finding on the record, which would provide a "good case" that the claimed design was primarily functional, cf. Carletti, 328 F.2d at 1021, 140 USPQ at 654, and appellant has not had an opportunity to respond to such a finding. Cf. In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-427 (CCPA 1976); In re Boon, 439 F.2d 724, 727-28, 169 USPQ 231, 234 (CCPA 1971). Thus, on this record, the ground of rejection as stated by the examiner

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must be reversed.

CHARLES F. WARREN	) BOARD OF PATENT
Administrative Patent Judge	) APPEALS AND
	) INTERFERENCES

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